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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,193	08/28/2003	Koichi Ohto	Q77191	6245

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT PAPER NUMBER

2826

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,193

Applicant(s)

OHTO ET AL.

Examiner

Alexander O. Williams

Art Unit

2826

~~— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —~~

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005 and 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-18, 51 and 213-218 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51 and 215-218 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-13, 213 and 214 is/are rejected.
- 7) ☒ Claim(s) 3-7 and 15-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 10/281,321.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/29/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2826

Serial Number: 10/650193 Attorney's Docket #: Q77191

Filing Date: 8/28/03; claimed foreign priority to 5/8/02; 10/17/03; 5/5/03

Applicant: Ohto et al.

Examiner: Alexander Williams

Applicant's RCE filed 12/15/05 and Amendment filed 11/15/05 to the election of Species I, figures 5A-8C (claims 1 to 17 and 51), filed 8/11/04, has been acknowledged.

This application contains claims 18-50, 52, 53 and 54-212 drawn to an invention non-elected with traverse. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (see 37 CFR § 1.144 & MPEP § 821.01).

Claims 14, 18-50 and 52-212 have been cancelled.

Receipt is acknowledged of papers (2003-130484) submitted under 35

U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copies (2002-0132780 and 2002-302841) have been

filed in parent Application No. 10/281321, filed on 10/28/2002.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, it is noted that the 35 U.S.C. § 103 rejection based on an insulating underlayer and a first insulating interlayer deals with an issue (i.e., the integration of multiple pieces into one piece or conversely, using multiple pieces in replacing a single piece) that has been previously decided by the courts.

In Howard v. Detroit Stove Works 150 U.S. 164 (1893), the Court held, "it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together...."

In In re Larson 144 USPQ 347 (CCPA 1965), the term "integral" did not define over a multi-piece structure secured as a single unit. More importantly, the court went further and stated, "we are inclined to agree with the solicitor that the use of a one-piece construction instead of the [multi-piece] structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice" (bracketed material added). The court cited In re Fridolph for support.

In re Fridolph 135 USPQ 319 (CCPA 1962) deals with submitted affidavits relating to this issue. The underlying issue in In re Fridolph was related to the end result of making a multi-piece structure into a one-piece structure. Generally, favorable patentable weight was accorded if the one-piece structure yielded results not expected from the modification of the two-piece structure into a single piece structure.

Claims 1, 2, 8 to 13, 213 and 214 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armbrust et al. (U.S. Patent # 6,251,775 B1).

1. For example, in claim 1, Armbrust et al. (figure 1) show a semiconductor device comprising: an insulating underlayer **10**; a first insulating interlayer **10** formed on said insulating underlayer, said first insulating interlayer having a groove (in which 11-13 sits); a first silicon-diffused metal layer **13** therein buried in said groove; and a first metal diffusion barrier layer **12** formed on said first silicon-diffused metal layer and said first insulating interlayer.

Therefore, it would have been obvious to one of ordinary skill in the art to use the insulating underlayer and the first insulating interlayer as "merely a matter of obvious engineering choice" as set forth in the above case law.

Claims 3-7 and 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 51 and 215-218 are allowed.

Response

Applicant's arguments filed 11/15/05 have been fully considered, but are moot in view of the new grounds of rejections detailed above.

The listed references are cited as of interest to this application, but not applied at this time.

Field of Search	Date
U.S. Class and subclass: 257/750,750,758,257,774,762	11/1/04 5/14/05 1/23/06

Art Unit: 2826

Other Documentation: foreign patents and literature in 257/750,750,758,257,774,762	11/1/04 5/14/05 1/23/06
Electronic data base(s): U.S. Patents EAST	11/1/04 1/23/06

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O Williams whose telephone number is (571) 272 1924. The examiner can normally be reached on M-F 6:30-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander O Williams
Primary Examiner
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1/23/06